

REMARKS

Claims 1-4, and 21-27 stand rejected.

Claims 5-20 have been deleted.

Claim 23 has been amended.

Claims 1-4, and 21-27 are pending.

As will be explained in detail below, Claim 21 has been amended so that it no longer contains a reference to a "public switched network." Claim 23 has been narrowed to indicate that the store and forward switch will be located at the said amenity location. Additionally, in claim 23, the term "facilitating" has been narrowed to include: collecting user information and initiating a routine for the offer of the movie responsive to receipt of a validation. Support for these amendments may be found throughout the document, including Fig. 8 and col. 5, lines 10-14, respectively. Additionally, the word "store" has been amended to the more narrow word "buffer." Support for this amendment can be found at col. 3. lines 17-21.

I. Objections and Statements

The Applicant acknowledges that the original patent or a statement as to the loss or inaccessibility of the original patent must be received before the reissue application can be allowed.

The Applicant also acknowledges that extensions of time are not available in this matter.

The Examiner has objected to the drawings under 37 CFR 1.83(a) requesting that the "central distribution box" and the "private switched network telephone system" be shown in the Figures. In response, attached is a photocopy of new Fig. 2a, subject to the Examiner's approval. Fig. 2a illustrates a central distribution box as described in at col. 5, lines 15-21 of the specification. Because Fig 2a illustrates an alternative embodiment previously described in the specification, this amendment does not add new matter. Additionally, numerical identifiers and references to Fig. 2a have been

added to the specification, in the paragraph beginning at col. 5, line 10. No other text has been added. As such, the addition of this text is not new matter.

Fig. 8 has been amended to specifically indicate a private switched network 180 as requested by the Examiner. Attached is an affidavit from William Fuller stating that any person skilled in the art would recognize that the switching network 180 is a private network. Thus, this amendment is simply a clarification of terminology and does not add new matter. Additionally, in the paragraph beginning at col. 9, line 43, a reference to the switching network 180 has been added. This is simply the addition of a term and a reference number to what was already implicit and fully supported in the text. Thus, no new matter has been added. A Request to Approve Drawing Changes is filed herewith.

II. Rejections under 35 U.S.C. 251

A. Central Distribution Box

Claims 1, 18-22, 24-27 were rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period. Specifically, the Examiner believes the terms "central distribution box" broadens the scope of the claims on the basis that the term box is broader than the term computer. The Examiner has stated "there is no description as to what constitutes the "central distribution box", i.e., the specifics such as the circuitry, etc. therefore its scope can be any conceivable product or process." The Applicant respectfully traverses this rejection.

As the MPEP states:

If elements of an invention are well known in the art, *the applicant does not have to provide a disclosure that describes those elements*. In such a case the elements will be construed as encompassing any and every art recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.

MPEP 2106 II(c) (emphasis added).

Thus, if the term "central distribution box" is a well known term in the industry, the specifics such as circuitry etc. do not have to be described. In the response to the

protest filed on May 1, 2002, the Applicant previously explained that the term "central distribution box" is the same as the well known terms "central distribution point" or "headend." In response, the Examiner has stated "there is no evidence of any sort presented to link a "central distribution box" to a "headend" or "central distribution point." The Applicant has attached the declaration of William Fuller. In this declaration, Mr. Fuller states that within the industry during the time when the Application was filed, the term "central distribution box" was a widely known term within the industry and was used interchangeably with the terms "central distribution point" or "headend." Because those who practice the art and the PTO recognize that a central distribution point or box is a common industry term, there is no need for additional definition of the term.

In his declaration, Mr. Fuller also explains that in the pay-per-view industry, the term "central distribution box" always includes a "central distribution computer" because a computer is necessary for tracking, billing and distributing the signals to individual rooms. Mr. Fuller's declaration is supported by the PTO's classification system. In the class definition of Class 725, subclass 4, the PTO states:

Data stored at intermediate point (i.e., at location between headend or server and receiver): This subclass is indented under subclass 1. Subject matter comprising means or steps for recording or storing use-related information at an intermediate system location for subsequent billing purposes.

<http://www.uspto.gov/go/classification/uspc725/defs725.htm> (emphasis added)
(See Appendix A).

In summary, the term "central distribution box" or "central distribution point," also referred to as a "head end," is a well known device that always contains a computer or processor when employed in pay-per-view systems.

Thus, these amendments are narrowing because a central distribution box in-pay-per-view systems must contain, in addition to other elements, a central distribution computer. As the Examiner has stated, the test for determining whether a claim has been broadened is whether the patent owner would be able to sue any party for infringement who previously could not have been sued. The applicant, under the original claims, could have sued those making, using, etc. all such claimed devices

containing a central distribution computer. However, because a central distribution boxes must contain a central distribution computer, the Applicant is not able to sue anyone under the amended claims that it could not have sued under the original claims. Thus, these claims could not possibly be broadening claims. Therefore, replacing the term "central distribution computer" with the term "central distribution box" does not constitute a broadening amendment and this rejection should be withdrawn.

? now
able to sue
box; headend
point.

B. The use of a "Store and Forward Switch" in Claim 23

1. The use of the term "Store and Forward Switch" does not broaden claims 23

Claim 23 was rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period. Specifically, the Examiner believes the terms "store-and-forward switch" in claim 23 broadens the scope of this claim because the amended claim contains a conceivable product or process which would not have infringed the original patent. The Applicant respectfully traverses this rejection.

The addition of a store-and-forward switch does not contain a conceivable product or process which would not have infringed the original patent. A store-and-forward switch ("SFS") that has a validating and/or distributing functionality would have to be a computer (and not a simple one-way speed dialer) to instruct the movie to be played. In order to emphasize this qualification, claim 23 has been amended to add the following:

providing a store-and-forward switch (SFS) connected at said amenity location for facilitating the offer of a movie by collecting user information and initiating a routine for the offer of the movie responsive to receipt of a validation;

Support for the above amendment is found at col. 5. lines 10-14. Thus, it is clear that the SFS used in amended claim 23 would have the same functionality as a central distribution computer. Therefore, for this type of store-and-forward switch, there must be a computer. See Mr. Fuller's affidavit, where he explains that a store-and-forward

switch must have a distribution computer because a computer is necessary for tracking, billing and distributing the signals to individual rooms.

Thus, these amendments are narrowing because a SFS in-pay-per-view systems must contain, in addition to other elements, a central distribution computer. As the Examiner has stated, the test for determining whether a claim has been broadened is whether the patent owner would be able to sue any party for infringement who previously could not have been sued. The Applicant, under the original claims, could have sued those making, using, etc. all such claimed devices containing a central distribution computer. However, because a SFS as used in claim 23 must contain a central distribution computer, the Applicant is not able to sue anyone under the amended claims that it could not have sued under the original claims. Thus, these claims could not possibly be broadening claims. Therefore, replacing the term "central distribution computer" with the term "store-and-forward switch" does not constitute a broadening amendment and this rejection should be withdrawn.

2. The use of the term "Store and Forward Switch" in claim 23 is not recapture

Claim 23 was rejected under 35 U.S.C. § 251 as being improper recapture of broadened claimed subject matter in a reissue application filed outside the two year statutory period. Specifically, the Examiner believes that replacing the term "central distribution computer" with the term "store-and-forward switch" constitutes recapture of material given up during the original prosecution. The Examiner argues that the SFS need not be on-site. The Examiner states that the applicants argued during the original prosecution that "the CDC is onsite and not connected to amenity location through the switched network, while the SFS need not be on-site." Thus, according to the Examiner, the replacement of CDC with SFS is "recapture of subject matter surrendered during prosecution of the original patent."

In order to expedite this Application, the Applicant has modified claim 23. As modified, the relevant step from claim 23 is:

providing a store-and-forward switch (SFS) connected [to] at said amenity location for facilitating the offer of a move;

It is now clear that the store-and-forward switch is connected at the location of the amenity or “on-site.” Support for this amendment may be found throughout the document, but specifically in Fig. 8. Therefore, because amended claim 23 specifies that the SFS must be on-site, the amended claim 23 does not recapture material given up during the original prosecution. Thus, the rejection should be withdrawn.

C. The use of a “Public and Private Switched Network” in Claim 21

Claim 21 was rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period. Specifically, the Examiner believes the terms “private switched network telephone system” and “public switched network system” in claim 21 broadens the scope of this claim because the amended claim contains a conceivable product or process which would not have infringed the original patent. The Examiner argues that “by adding the terms public and private the scope of the claims of new reissue claim 21 as compared to patent claim 1 is broadened.” In this Amendment, the Applicant has replaced the word “public” with the word “private,” so this rejection regarding “public networks” is now moot.

D. The use of the word “Private” does not broaden the claim

It is “black letter” patent law that adding an adjective (i.e., “private” to the term “switched network”) to the claim results in the narrowing of the claim. However, in contrast to the ordinary English usage, the Examiner has argued that the term “switch network” must necessarily be limited to a “public switched network.” Thus, a private switched network would specifically be excluded from the Examiner’s definition. The Examiner’s relies on a definition is from a 1989 version of Newton’s Telecom Dictionary. The Applicant respectfully traverses the Examiner’s definition of the term “switched network” and offers the following definitions:

switched network: 1. A communications network, such as the public switched telephone network, in which any user may be connected to any other user through the use of message, circuit, or packet switching and control devices. 2. Any network providing switched communications service.

This definition is from the Federal Standard 1037C, which is a Glossary of Telecommunication Terms, FED-STD-1037C, Prepared by the National Communications System Technology & Standards Division and published by the General Services Administration in 1996 (see Exhibit 1). This definition is also the same definition for "switched network" used in the current American National Standard T1.523-2001, (see Exhibit 2).

Another definition of "switched networks" can be found in AT&T's Engineering and Operations in the Bell System, a 1989 printing (see Exhibit 3):

Switching Network - Switching stages and their interconnections with a switching system.

Switching System – an electromechanical or electronic system for connecting lines to lines, lines to trunks, or trunks to trunks. The term *includes* private branch exchange switching systems and centrally located network switching systems.

The AT&T definitions are further supported by Mr. Fuller, who in his affidavit states that it was well known at the time of filing the Application, that a "switching network" is the same as a "switched network." Furthermore, in the early nineties, Mr. Fuller states that AT&T's book "Engineering and Operations in the Bell System" was far more accepted by the industry than Newton's Telecom Dictionary. Mr. Newton was a magazine publisher, not an engineer. Professional engineers relied on the books from AT&T (see Mr. Fuller's Declaration - Exhibit 4).

Even today, Newton's Telecom Dictionary, although helpful, is not completely authoritative. For instance, Newton's 17th Edition of the Dictionary uses the same definition as in the 1989 printing, which was referenced by the Examiner. Yet, as already discussed, the current American National Standards Institute standard specifically states that a switched network is any network providing switched communications service – which is a very different definition. Thus, it is clear that the term "switched network" should be given its common usage and "plain English" definition. In other words, the term "switched network" means "any network providing

switched services" Additional adjectives, such as "public," should not be read into the definition.

Without question the term "switched network" includes both private switched networks and public switched networks. Thus, claim 23 has been only been narrowed from an apparatus for processing information in a switched network to an apparatus for processing information in a private switched network. The Applicant wishes to draw the Examiner's attention to the MPEP 1412.03, pages 1400-16 where it states that the test for determining whether a claim has been broadened is whether the patent owner would be able to sue any party for infringement who previously could not have been sued. By narrowing the claim to include only private networks, the Applicant is not able to sue anyone under the amended claim 21 that it could not have sued under the original claims. Thus, claim 21 could not possibly be a broadening claim. The Examiner' s rejection, therefore, should be withdrawn.

E. The use of a "Private Switched Network" in Claim 21 is not new matter

Claim 21 was rejected under 35 U.S.C. § 251 as being based upon new matter added to the present patent for which reissue is sought. Specifically, the Examiner believes that the term "private switched network" is new matter. The Applicant respectfully traverses this rejection.

First, as discussed above, one skilled in the art would know that the term "switched network" inherently includes private networks. According to the Federal Circuit, "the fundamental inquiry is whether the material added by amendment was inherently contained in the original application." *Schering Corp. v. Amgen Inc.*, 55 USPQ2d 1650, 1655 (Fed. Cir. 2000). Thus, the mere addition of the term "private" does not add new matter because one skilled in the art would know that the term "switched network" includes "private switched networks."

Second, as explained previously, it is clear from the specification and drawings that at least one of the networks discussed in the specification was a private switched network. Refer to col. 9, lines 50-59 of the specification, which states:

The co-located amenity 132 allows the store-and-forward switch 20 to interface the amenity 132 through the switched network 22 directly with the access phone 10 without placing an outgoing call. In this manner, the call processing features of the store-and-forward switch 20 can be performed without placing an outgoing call but the co-located amenity 132 is still connected to the access phone 10, similar to that chart described above with reference to FIGS. 1 and 2.

It is clear from the above excerpt from the specification that the switched network 22 is a private switched network. If not, the term "without placing an outgoing call" would be nonsensical.

As the Federal Circuit's predecessor court explained:

By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

In re Smythe, 178 USPQ 279, 285 (C.C.P.A. 1973).

Because a private switched network is inherent in the original specification, the Applicant, can now claim a "private switched network" without it being "new" matter.

Third, as explained above, the specification and the drawings have now been amended to specifically include the term "private switched network." This amendment is not new matter because anyone skilled in the art would know that the invention described in the specification and drawings that the application inherently contained a private network (see Exhibit 4). Consequently, the introduction of the word "private" to the term "switched network" is not new matter and the Examiner' rejection should be withdrawn.

III. Rejections under 35 U.S.C. 112

A. Claims 2-17

Claims 2-17 were rejected under 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In order to expedite this Application, the Applicant has cancelled these claims. So, this rejection is now moot.

B. Central Distribution Box

Claims 1, 18-22, 24-27 were rejected under 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner believes that there is no description as to what constitutes a "central distribution box." The Applicant respectfully traverses this rejection.

As discussed in Mr. Fuller's affidavit, the term "central distribution box" is synonymous with the term "central distribution point"¹ which is a well known component in a pay-per-view system (see Exhibit 4). It is the source of the signal for playing movies on televisions. Therefore, the descriptions in the specification of the central distribution box are sufficient, and additional descriptions of what constitutes a central distribution box, are not necessary. As the MPEP states:

If elements of an invention are well known in the art, the applicant does not have to provide a disclosure that describes those elements. In such a case the elements will be construed as encompassing any and every art recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.

MPEP 2106 II(c) (emphasis added).

¹ The term "central distribution point" or "central distribution box" is also sometimes referred to as a "head end" within the industry.

It is emphasized that term central distribution box (i.e., central distribution point) is a term so well known in the art that is referenced in the PTO's classification system. For instance, in the class definition of Class 725, subclass 2, the PTO states:

This subclass includes means or steps for electronically retrieving locally stored data for further *processing at a central distribution point, such as a headend.*

<http://www.uspto.gov/go/classification/uspc725/defs725.htm> (Appendix A)

Because those who practice the art and the PTO recognize that a central distribution point or box is a common industry term, there is no need for additional definition of the term.

The functionality of the term is defined in the specification and one skilled in the art would know exactly what the term meant from reading the specification. The term "Central Distribution Box" is found in Col. 5, line 15 through 18 of the specification. This text is reproduced below:

For example, if the in-room amenity were a television that offered movies, a central distribution box could be located in the hotel establishment. The store-and-forward switch 48 could access this central distribution box through an extension on the PBX 12 and route the appropriate information therethrough. In this manner, the billing information, etc., is stored at the store-and-forward switch 48 through use of the computer 50 and then the in-room amenity 54 activated.

(Emphasis added).

Thus, the functionality of the central distribution box provides for the offering of movies through a television as the in-room amenity. The central distribution box is "located in the hotel establishment" and is used to distribute movies to the "in-room amenity" (through a television). The central distribution box is accessed "through an extension on the PBX 12" inside the hotel establishment. Accordingly, the central distribution box connects directly to the in-room amenity without connecting back to the in-room amenity through the switched network telephone system.

Furthermore, it is understood by one of ordinary skill in this industry that, as contrasted with the previously claimed "central distribution computer," a central

distribution box (i.e., a "head end") located at the establishment is a device that is specifically designed to connect directly with the amenity device (e.g., to the television) to deliver the signal for a pay per view movie without going through a public switched telephone network system.

Thus, there is a sufficient written description in the Application for the term "central distribution box." It is well settled that the specification "need only be reasonable with respect to the art involved; they need not inform the layman nor disclose what the skilled already possess." *General Electric Co. v. Brenner*, 159 USPQ 335, 337 (D.C. Cir. 1968). Because the term was well known in the industry and the functionality of the term was completely described, there is no need for additional description. The examiner, therefore, should withdraw his rejection.

C. Billing Computer

Claim 23 was rejected under 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner believes that the specification is inadequately written to provide support for the limitation "said billing computer instructing said SFS to offer said movie at said amenity location." In order to expedite this Application, the Applicant has modified claim 23. The relevant portion of modified claim 23 is reproduced below:

23. (Amended) [From claim 2] A method of user access to movies at an amenity location, the method comprising:

responsive to said user input, validating in said central billing computer said user billing information; and responsive to said validation, said billing computer instructing said SFS [to offer] to activate said movie at said amenity location.

Support for this amendment may be found in the specification at col. 5, lines 10-15 and at col. 8, lines 20-30. Thus, the specification does provide support for the

modified claim 23. The Examiner's rejection of claim 23, therefore, should be withdrawn.

Claim 23 has also been amended to correct a minor informality relating to consistency of terms and antecedent basis. Specifically, the Claim 23 was corrected so that all subsequent references to the billing computer are consistent.

D. Private Switched Network

Claim 21 was rejected under 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner believes that the specification fails to provide an adequate written description to support a "private switched network." The Applicant respectfully traverses this rejection.

Notwithstanding the general descriptions of private and public network in the patent and claims, the Applicant respectfully contends that the word "private" does not need a detailed description because the term "private" and "private network telephone system" are well known terms in the art. As explained in Mr. Fuller's affidavit, anyone skilled in the art would have known what is meant by the terms "private network telephone system" or "private switched network" and that a private switched network was described in the specification (see Exhibit 4).

Turning again to the MPEP:

If elements of an invention are well known in the art, *the applicant does not have to provide a disclosure that describes those elements*. In such a case the elements will be construed as encompassing any and every art recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.

MPEP 2106 II(c) (emphasis added).

Thus, there is no need for additional disclosure for the terms "private network telephone system" or "private switched network specification." The Examiner, therefore, should withdraw this rejection.

IV. Conclusion

In summary, as amended, the reissue claims presented herein meet all of the requirements for reissue claims, including no introduction of new matter and the written description requirements. It is respectfully submitted, therefore, that they be allowed by the Examiner.

Respectfully submitted,



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